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10/755,755	01/12/2004	Hans Erik Schmidt	2424-30	9597
29540	7590	05/30/2006	EXAMINER	
PITNEY HARDIN LLP			TRETTEL, MICHAEL	
7 TIMES SQUARE			ART UNIT	
NEW YORK, NY 10036-7311			PAPER NUMBER	
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**MAILED**

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**GROUP 3600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/755,755  
Filing Date: January 12, 2004  
Appellant(s): SCHMIDT, HANS ERIK

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Pitney Hardin LLP  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed March 17, 2006 appealing from the Office action mailed November 22, 2005.

Art Unit: 3673

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claim 2.

Claim 2 has been amended subsequent to the final rejection.

Claims 1 and 3-9 have been canceled.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

A substantially correct copy of appealed claim 2 appears on page 9 of the Appendix to the appellant's brief. The minor errors are as follows: a clean copy of the claim was not presented. For the convenience of the Board a clean copy of appealed claim 2 is set forth below.

**Claim 2**      A sleeping device, such as a pillow, mattress or quilt, for minimizing temperature variations during sleep, wherein the sleeping device comprises a first layer (113,121,131) of a phase change material having temperature regulating properties and a second layer of down filling (111,123,129).

**(8) Evidence Relied Upon**

<b>5,722,482</b>	<b>Buckley</b>	<b>3-1998</b>
<b>4,706,304</b>	<b>Jones</b>	<b>11-1987</b>
<b>4,479,270</b>	<b>Novinger</b>	<b>10-1984</b>

(Extrinsic Evidence to Support taking of Official Notice ONLY. These references are not part of the basis of the art rejection.)

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley (US 5,722,482). Buckley shows a thermal control device formed by attaching a layer 21 with integrated PCM material 20 with at least one additional layer of insulating material. The device can be formed as a blanket for use in thermal control of a febrile patient. As described in column 4 and shown in Figure 2, the device can be formed as a laminated structure with a layer B being formed from a PCM type material. An insulating layer A can be attached to one side of the layer B to form an exterior surface of the composite. A similar insulating layer C can be attached to the opposed side of layer B, and forms an interior side of the composite which can be placed against the skin of a user. Both layers A and C are specified as being formed from thermally insulating materials such as a plastic foam (column 4, line 59) with layer C being thinner than layer A. The examiner takes notice that while plastic foam is specified as being the preferred material, a large class of materials are available which qualify as insulating materials. Such materials include but are not limited to down, feathers, textiles such as cotton or polyester materials, wool, latex foams, and so forth. Because the equivalence of these insulating materials is well known within the art it would have been obvious to the skilled artisan to have used any one of these equivalent materials such as down as one of the insulating layers A, C in the Buckley thermal control device.

### (10) Response to Argument

The appellant has argued that the 103(a) rejection is improper because the examiner has failed to make out a *prima facie* case of obviousness in view of the Buckley reference. To this end, the appellant has argued on page 6 of the Brief that the examiner has used an “obvious to try” rationale when making the 103(a) rejection. This is not the rationale used by the examiner when making the rejection. Because Buckley does not explicitly state or teach the use of a down filling layer in combination with the layer of PCM material the examiner took OFFICIAL NOTICE that the use of a foam insulating layer used by Buckley is equivalent to other well known insulating layers used in the art. These other notoriously well known equivalents were listed in the rejection, and include materials such as down, feathers textiles such as cotton or polyester materials, wool, latex foams, and the like. It should be noted that the appellant has not explicitly traversed this rationale, but has instead attempted in the arguments to shift the logic used by the examiner to an “obvious to try” rationale. In support of the Office’s position as used in the rejection the examiner has cited two new references for the Board’s consideration. The first reference is the U.S. Patent to Novinger (US 4,479,270) which shows an insulating article of apparel. In column 3, lines 25 to 29 Novinger states the following when discussing the insulating layer used in the article (emphasis added):

“The tubular material, say in the form of a fabric may be suitable for any well known conventional sewing machines which can stitch a longitudinal seam on a strip of material formed as a flat tube, and thereafter turn the tube inside out so the raw edges are internally disposed. Such a tube can then be filled with any predetermined insulation material, depending upon the application and properties desired. For example, any of the following materials may be utilized as the insulating material; *down*, cotton, cork, paper, wood, water, *foam materials*, polyfill, glass and other like materials.”

Art Unit: 3673

The second reference is the U.S. Patent to Jones (US 4,706,304). This patent is also drawn to an insulating article of apparel, in column 2, lines 52 to 64 Jones states the following about the insulating materials used in the apparel construction (emphasis added):

“The garment may be made of various materials or combinations of materials. For example, it may be made of wool, cotton, leather, denim, synthetics (e.g., polyester, rayon, taslon, nylon, acrylic, nylon taffeta, polyurethane), etc. It may be knitted or woven. It may also include thermal insulation (e.g., *down*, or synthetic insulating material, *foam*), if desired. The arm portions of the garment may be made of one material and the central portion (which connects the two arm portions) may be composed of an entirely different material, if desired. The central portion may even be composed of straps or a strip of flexible material (e.g., cloth or leather).”

Both of these references are drawn from the same body of art as is the Buckley patent, and both demonstrate that the examiner’s position is well supported and is based upon facts notoriously well known in the art. For this reason the examiner feels that the argument asserting the use of an “obvious to try” rationale is without merit.

The appellant has also argued that the examiner has not demonstrated a reasonable expectation of success. This is apparently based upon the assertion that the claim limitation is drawn to a use as a sleeping device which defines over the Buckley reference due to the differing intended use of Buckley verses that of the claimed invention. This was dealt with in detail in the rejection, but the examiner will note that this limitation does not necessarily mean what the appellant apparently desires it to mean. The limitation in question states “for minimizing temperature variations during sleep” which as noted in the rejection can easily be read upon the insulating material shown by Buckley. Any degree of minimizing temperature variation during sleep is sufficient to meet this limitation, and as noted in the Final Rejection Buckley discloses a

Art Unit: 3673

device meant to be used in clothing which is inherently capable of use as a for "minimizing temperature variations during sleep". People sleep while wearing clothing every day, with the clothing serving to minimize temperature variations. Minimizing temperature variations is a primary function of any type of insulating apparel-whether the apparel is intended primarily or secondarily for use during sleep is at best a secondary consideration.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

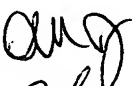
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
Michael Trettel

Primary Examiner

Conferees:

Darnell Jayne 

Michael Safavi 